

REMARKS

Claims 1-19 are pending in the Application. No claims have been amended, canceled or added, leaving claims 1-19 for consideration.

1. **Rejection of claims 12-14 under 35 U.S.C. §112, second paragraph.**

Claims 12-14 stand rejected under 35 U.S.C. §112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular, the Examiner states that the recitations "complementary" are considered indefinite because the recited term is not defined in the specification. Applicants respectfully traverse this rejection.

Applicants respectfully maintain that the recitation "complementary" is not indefinite as was asserted in a previous Office Action. Case law holds that "[d]efiniteness of claim language must be analyzed, not in a vacuum, but in light of (1) the content of the particular Application disclosure, (2) the teachings of the prior art, and (3) the claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made." See, e.g., *In re Marosi*, 710 F.2d 799, 218 U.S.P.Q. 289 (Fed. Cir. 1983); *Rosemount, Inc. v. Beckman Instruments, Inc.*, 727 F.2d 1540, 221 U.S.P.Q. 1 (Fed. Cir. 1984); *W.L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 U.S.P.Q. 303 (Fed. Cir. 1983).

(1) The content of the particular Application disclosure: Applicants disclose thermally curable, thixotropic mixtures containing carbamate and/or allophanate groups. The Application further relates to processes for preparing the heat-curable thixotropic mixtures, and to their use as coating materials, adhesives and sealing compounds. (See at least paragraphs 0001, 0017, 0021-0032, and claims in the present Application as filed.)

(2) The teachings of the prior art: It is well known in the prior art that "complementary", when used to describe functional groups, refers to groups that are reactive with said functional groups. For example, U.S. Patent No. 7,098,257 refers to complementary groups, in terms of (meth)acrylate polymers, as groups that are reactive with acrylate and methacrylate polymers.

(3) The claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made: taking into account the above, and referring to examples of complementary groups in the specification, for example, paragraph 0052, one skilled in the art at the time the invention was made would understand that complementary refers to “reactive with”, and guided by the non-limiting examples disclosed in paragraph 0052 of the specification as filed, can determine suitable complementary groups according to the disclosure.

2. Rejection of claims 1-19 under 35 U.S.C. §102(e) as being anticipated by or, in the alternative, under 35 U.S.C. §103(a) as obvious over Voris et al., U.S. 7,056,522, hereafter “Voris” or “522”.

Rejection under 35 U.S.C. §102(e)

Applicants respectfully assert that the present Application is patentable over Voris under 35 U.S.C. §102(e) for at least two reasons:

(1) Voris is not analogous art. For the purposes of evaluating [obviousness of] claimed subject matter, the particular references relied upon must constitute “analogous art”. *In re Clay*, 966 F.2d 656, 659, 23 U.S.P.Q.2d 1058, 1060-61 (Fed. Cir. 1992). The present Application relates to the use of novel heat-curable thixotropic mixtures containing carbamate and/or allophanate groups as coating materials, adhesives, and sealing compounds. In particular, it relates to the use of novel heat-curable thixotropic coating materials containing carbamate and/or allophanate groups as clearcoat material, especially for producing clearcoats as part of multicoat color and/or effect coating systems (present Application as filed, paragraph 0001). Voris, on the other hand, relates to sustained release pest control products and their Applications (Voris, title). Specifically, Voris relates to a method for applying and delivering pesticides, insecticides and repellents to structures, surfaces of structures, and materials important to commerce and industry, and more particularly to polyurethane polymer systems containing pesticide(s) and or pellets containing bioactive active chemicals having extremely long useful lives (Voris, column 1, lines 19-25). Since the present Application does not relate to applying and delivering pesticides, but to adhesives and coating materials, Applicants respectfully assert that Voris is not analogous art.

(2) If Voris were analogous art, which Applicants dispute, then Applicants respectfully assert that the present Application is patentable over Voris under 35 U.S.C. §102(e) because Voris fails to disclose each and every element of independent claim 1. To anticipate a claim under 35 U.S.C. § 102, a single source must contain all of the elements of the claim. *Lewmar Marine Inc. v. Barient, Inc.*, 827 F.2d 744, 747, 3 U.S.P.Q.2d 1766, 1768 (Fed. Cir. 1987).

Voris teaches that hard segments of a polymer chain are crystalline or crosslinked. They resist permeation by water and oxygen (Voris, column 9, lines 56-57). Voris then adds that there are six types of crosslinks, some of which can be broken under stress and re-formed. The six types of crosslinking are:

1. Use of isocyanates with functionality greater than 2.
2. Use of low molecular weight polyols with functionality greater than 2.
3. Use of polyols with functionality greater than 2
4. Crosslinking by allophanate formation.
5. Reaction of ureas with isocyanate groups to form biuret groups.
6. Virtual crosslinking via Hydrogen Bonding.

(Voris, column 10, lines 5-67).

As can be seen above, Voris is only teaching that there are six possible types of crosslinking, and out of the six possibilities, one possibility can be allophanate formation, and another possibility can be attributed to the reaction of ureas. Voris does not teach, as claimed in independent claim 1 of present Application, that a mixture containing allophanate groups comprises both (A) at least one oligomer and/or polymer that contains at least one allophanate group or contains one carbamate group and at least one allophanate group, and (B) at least one thixotropic agent comprising a urea or a urea derivative prepared by reacting at least one amine and/or water with at least one polyisocyanate (emphasis added.)

As such, Applicants respectfully assert that independent claim 1, and consequently claims 2-19 which depend from claim 1, are patentable over Voris under 35 U.S.C. § 102. Reconsideration and withdrawal of the rejection are respectfully requested.

Rejection under 35 U.S.C. §103(a)

Applicants respectfully assert that the present Application is patentable over Voris under 35 U.S.C. §103(a) for at least two reasons:

(1) Voris is not analogous art. As discussed above, Voris is not analogous art as it relates to pesticides, whereas the present Application relates to adhesives and coating materials.

(2) If Voris were analogous art, which Applicants dispute, then Applicants respectfully assert that the present Application is patentable over Voris under 35 U.S.C. §103(a) because Voris fails to teach or suggest every element of independent claim 1. For an obviousness rejection to be proper, the Examiner must meet the burden of establishing that all elements of the invention are disclosed in the prior art; that the prior art relied upon, coupled with knowledge generally available in the art at the time of the invention, must contain some suggestion or incentive that would have motivated the skilled artisan to modify a reference or combined references; and that the proposed modification of the prior art must have had a reasonable expectation of success, determined from the vantage point of the skilled artisan at the time the invention was made. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988); *Amgen v. Chugai Pharmaceuticals Co.*, 927 U.S.P.Q.2d, 1016, 1023 (Fed. Cir. 1996).

As discussed above, Voris only lists possible ways of crosslinking a polyurethane polymer. There would be no motivation for someone skilled in the art at the time the invention was made to specifically combine 2 methods of crosslinking listed by Voris to arrive at disclosed independent claim 1, especially since Voris does not relate to coatings and adhesives. The Examiner refers to the composition disclosed by Voris and that disclosed by Applicants as "substantially identical". Applicants respectfully reiterate that Voris does not disclose a composition comprising at least one oligomer and/or polymer that contains at least one allophanate group or contains one carbamate group and at least one allophanate group, and (B) at least one thixotropic agent comprising a urea or a urea derivative prepared by reacting at least one amine and/or water with at least one polyisocyanate, and in no way discloses a substantially identical composition. Voris discloses a composition comprising a transport polyurethane polymer, and a pellet comprising a pesticide incorporated into a pellet polymer. Voris

only refers to the allophanate groups and the urea each as a possible method of crosslinking a polymer to form a hard segment, and gives no motivation that the specific combination of at least one oligomer and/or polymer containing at least one allophanate group and at least one thixotropic agent comprising a urea or a urea derivative can produce a heat curable thixotropic mixture as presently disclosed.

As such, Applicants respectfully assert that independent claim 1, and consequently claims 2-19 which depend from claim 1, are patentable over Voris under 35 U.S.C. § 103. Reconsideration and withdrawal of the rejection are respectfully requested.

CONCLUSION

Applicants respectfully submit that the Application and pending claims are patentable in view of the foregoing remarks. A Notice of Allowance is respectfully requested. As always, the Examiner is encouraged to contact the Undersigned by telephone if direct conversation would be helpful.

Respectfully Submitted,

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